REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims are not anticipated under 35 U.S.C. § 102 and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. **If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.**

The applicants will now address each of the issues raised in the outstanding Office Action.

Rejections under 35 U.S.C. § 102

Claims 1-19, 23-32, 35-38, 42-60, 64-73 and 76-79 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,948,061 ("the Merriman patent"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

First, since claims 4-12, 14-17, 23-28, 45-53, 55-58 and 64-69 have been canceled, this ground of rejection is rendered moot with respect to these claims.

Next, independent claims 1, 13, 42 and 54, as amended, are not anticipated by the Merriman patent because the Merriman patent does not teach the

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combination of: accepting, by the ad server system, document relevance information including at least one concept extracted from content of a document requested by the client device, wherein the document relevance information is generated and sent to the ad server system by at least one of (A) a browser application on the client device, (B) a browser plug-in on the client device, and (C) a browser toolbar on the client device, wherein the document relevance information is automatically extracted from the document requested; b) determining, by the ad server system, at least one ad relevant to content of the document using at least the accepted information to find matching serving constraints stored in association with ads; and c) sending, by the ad server system, the at least one ad determined to the client.

Exemplary embodiments consistent with the claimed invention advantageously resolve shortcomings of some client-side advertising software systems by helping the ad server show more relevant ads and enhance the experience of end users by serving ads **relevant to the content of the documents requested by the end user.** Specifically, as described in the present application, some client-side advertising software systems may show ads which:

> may be targeted to users using (i) demographic and lifestyle profiles, (ii) behavioral targeting (which allows targeted, customize messages to be displayed on users' computer screens based on their individual online behavior), (iii) historical targeting (which allows targeted,

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customized ads to be displayed on
users' computer screens based on
past behavior), and (iv) tag-a-
long targeting (which allows
targeted, customized ads to be
displayed on users' computer
screens whose online behavior has
indicated an interest, but also
delivers multiple impressions as
they travel around the Web).
Unfortunately, although past user
behavior is often a useful metric
for determining what ad(s) to
serve to a user, *such past
behavior might not be indicative
of a current user interest.*
Further, *past user behavior for a
given user may be difficult to
track if more than one person
(such as different members of a
family) use the same computer and
browser to access the Internet.*
Furthermore, tracking the online
habits of a user raises delicate
issues of that user's privacy.
Moreover, *if such past user
behavior is stored locally on the
user's computer, it may consume
needed storage resources.*
[Emphasis added.]

(Page 4, line 30 through page 5, line 14 of the present
application)

By contrast, exemplary embodiments consistent with
the claimed invention *do not require the use of specific
user information as described above to determine relevant
ads.* Specifically, the claimed invention is directed to
a content-relevant ad server for serving content-relevant
ads and a client device (such as an end user system for
example) which may include one or more applications for
(1) requesting one or more content-relevant ads, and (2)
rendering content-relevant ad(s) with content of a

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requested document. The request for ___content-relevant___
ad(s) may include:

> information about the requested
> document such as (i) content from
> the document, (ii) relevance
> information (e.g., concepts,
> topics, categories,
> classifications, etc.) of the
> content of the document, and/or
> (iii) a document identifier (e.g.,
> a URL of a Web page). Returned
> content-relevant ads may be
> rendered in association with the
> content of the document in any
> number of ways….

(Page 15, line 32 through page 16, line 4 of the present
application) That is, ___ads relevant to the content of the___
___document requested by a user are determined___.

For example, an application residing on a client
device may submit an ad request to the ad system. The
request includes information about a document on (or
requested by) the client device (e.g., a Web page on a
content rendering application such as a Browser, an
e-mail on an e-mail application, etc.). Specifically,
the ad request may include information about the
document, wherein the information is ___"document relevance___
___information including at least one concept of the content___
___of the document, and wherein the document relevance___
___information is automatically extracted from the document___
___requested"___.

Thus, independent claims 1, 13, 42 and 54, as
amended, are not anticipated by the Merriman patent for
at least the foregoing reasons. Since claims 2 and 3
directly or indirectly depend from claim 1, since claims
18, 19, 29-32 and 35-38 directly or indirectly depend

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from claim 13, since claims 43 and 44 directly cr
indirectly depend from claim 42, and since claims 59, 60,
70-73 and 76-79 directly or indirectly depend from claim
54 are similarly not anticipated by the Merriman patent.

Rejections under 35 U.S.C. § 103

Claims 20-22 and 61-63 are rejected under 35 U.S.C.
§ 103(a) as being unpatentable over the Merriman patent.
The applicants respectfully request that the Examiner
reconsider and withdraw this ground of rejection in view
of the following.

The Examiner states that the Merriman patent does
not expressly show the rendering location of an ad window
relative to the content of a document, such as Web page
window location. (See Paper No. 20090416, page 5.) The
Examiner argues that it would have been obvious to one of
ordinary skill in the art at the time of the invention to
render any window in any location. However, since claims
20-22 indirectly depend from claim 13, and since claims
61-63 indirectly depend from claim 54, regardless of
whether or not the Examiner's assertions regarding the
location of the second window are correct, claims 13 and
54, as amended (discussed above) are patentable for the
reasons provided above. Therefore, these claims are not
rendered obvious by the Merriman patent for at least the
reasons discussed with respect to claims 13 and 54 above.

Claims 33, 34, 39-41, 74, 75 and 80-82 are rejected
under 35 U.S.C. § 103(a) as being unpatentable over the
Merriman patent in view of U.S. Patent No. 6,892,354
("the Servan-Schreiber patent"). The applicants

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respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

In rejecting claims 33, 34, 39-41, 74, 75 and 80-82, the Examiner states that the Merriman patent does not teach that the act of submitting a request for at least one content-relevant ad to the content-relevant ad server occurs before a request for the requested document. (See Paper No. 20090416, page 6.) However, the Examiner cites column 3, lines 56-67 of the Servan-Schreiber patent as teaching submitting an ad request before a request for a document. The Examiner concluded that it would have been obvious to submit a request for ads before the document request in the Merriman patent because doing so would keep the user interested in the document or Website while the Website is downloading. (See Paper No. 20090416, page 6.)

First, dependent claims 33, 34 and 39-41 directly or indirectly depend from claim 13 and claims 74, 75 and 80-82 directly or indirectly depend from claim 54. Claims 13 and 54, as amended (discussed above), are patentable for the reasons provided above. Therefore, these claims are not rendered obvious by the Merriman and Servan-Schreiber patents for at least the reasons discussed above with respect to claims 13 and 54.

Thus, the applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection.

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Claim Amendments

Independent claim 1 has been amended to recite that each of the acts of the computer-implemented method is performed by an ad serving system including at least one computer on a network. In addition, independent claim 13 has been amended to recite that each of the acts of the computer-implemented method is performed by either the client device or the content relevant ad-server system. These amendments are supported, for example, by element 120' of Figure 2, elements 410a, 410b, 420 and 430 of Figure 4, Figure 7, page 24, line 4 through page 25, line 22 of the specification.

Furthermore, independent claims 42 and 54 have been amended to remove means-plus-function elements and to include at least one processor, an input device, and at least one storage device storing a computer executable code which, when executed by the at least one processor, performs a method. The claims which depend from claims 42 and 54 have been similarly amended. These amendments are supported, for example, by Figure 7, page 24, line 4 through page 25, line 22 of the specification.
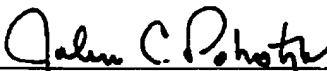
Conclusion

In view of the foregoing amendments and remarks, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

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Any arguments made in this amendment pertain **only** to
the specific aspects of the invention **claimed**. Any claim
amendments or cancellations, and any arguments, are made
without prejudice to, or disclaimer of, the applicants'
right to seek patent protection of any unclaimed (e.g.,
narrower, broader, different) subject matter, such as by
way of a continuation or divisional patent application
for example.

Since the applicants' remarks, amendments, and/or
filings with respect to the Examiner's objections and/or
rejections are sufficient to overcome these objections
and/or rejections, the applicants' silence as to
assertions by the Examiner in the Office Action and/or to
certain facts or conclusions that may be implied by
objections and/or rejections in the Office Action (such
as, for example, whether a reference constitutes prior
art, whether references have been properly combined or
modified, whether dependent claims are separately
patentable, etc.) is not a concession by the applicants
that such assertions and/or implications are accurate,
and that all requirements for an objection and/or a
rejection have been met. Thus, the applicants reserve
the right to analyze and dispute any such assertions and
implications in the future.

Respectfully submitted,

October 20, 2009

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper (and any accompanying paper(s)) is being facsimile transmitted to the United States Patent Office on the date shown below.

John C. Pokotylo
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October 20, 2009 .
Signature   Date

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